

## REMARKS

The Examiner noted that the applicant has not filed a certified copy of the JP 2003-432411 application as required by 35 U.S.C. 119(b).

The Examiner noted that the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims and noted that:

- (a) The drive means incorporated into an accessory type of casing of claim 1+ claim 3 must be shown or the feature(s) canceled from the claim(s); and
- (b) The convex surface of claim 6 must be shown or the feature(s) canceled from the claim(s).

The Examiner objected to the disclosure because of the following-informalities:

- (a) Page 1 of the specification lists JP 2003-348208 as 'Patent document' though no indication of its relevance has been made, and it was not listed in the IDS, nor was a copy submitted for review; and
- (b) Pages 6-9 of the specification refer to Figs. 1(a) and 1(b); however the drawings only have Fig. 1 labeled.

The Examiner rejected Claims 1-5, 7, 9-12 and 17-20 under 35 U.S.C. 103(a) as being unpatentable over Kubo (US Patent 5,883,966) in view of Teshima et al. (US PGPub 2003/0112993 A1). The Examiner also rejected Claims 6 and 13-16 under 35 U.S.C. 103(a) as being unpatentable over Kubo (US Patent 5,883,966) in view of Teshima et al. (US PGPub 2003/0112993 A1) as applied to claims 1-5 above, and further in view of Lee et al (US PGPub 2006/0262954).

**35 U.S.C. § 103(a)**

The Examiner rejected Claims 1-5, 7, 9-12 and 17-20 under 35 U.S.C. 103(a) as being unpatentable over Kubo (US Patent 5,883,966) in view of Teshima et al. (US PGPub 2003/0112993 A1)

**Re Claim 1:**

The Applicant respectfully submits that the invention as claimed in Claim 1, as amended, is not unpatentable over Kubo (US Patent 5,883,966) in view of Teshima et al. (US PGPub 2003/0112993 A1).

More particularly, the claimed invention enables a single bone-conduction speaker to serve both in voice communication and in outputting an incoming tone and eliminates the usage of a pressure type speaker as shown in Kubo (US Patent 5,883,966).

The Applicant respectfully disagrees with the Examiner that it would have been obvious to one of ordinary skill in the art to modify the telephone speaker of Kubo into a bone conduction speaker. In Kubo (US Patent 5,883,966), the speaker casing protrudes from the front end of the casing part due to the action of a coil spring which is not a “drive means” as explained *infra* (Re claim 7) to form an air chamber behind the speaker. Further, the first and second rubber rings are used to separate the speaker and the outer casing. Thus, the speaker in Kubo (US Patent 5,883,966) is not kept in constant contact with the outer casing when the speaker casing is on standby and when an incoming signal is received. Kubo actually teaches away from keeping the speaker in contact of the outer casing (Col 3, lines 45-47 states “ Rubber rings...” ). Examiner has pointed out that Figure 4 shows direct contact, however this contradicts the entire 10/561,378

purpose of Kubo's invention. Therefore there is no motivation to replace the speaker in Kubo (US Patent 5,883,966) with a vibration actuator (which is not a bone conduction speaker) as disclosed in Teshima et al. (US PGPub 2003/0112993 A1) to arrive at the claimed invention. The alleged combination of the speakers of Kubo (US Patent 5,883,966) and Teshima et al. (US PGPub 2003/0112993 A1) references would not result in the invention as claimed in Claim 1.

Respectfully, Applicant does not believe further search and consideration is required because Claim 5 was incorporated into Claim 1 with minor changes and the Applicant respectfully submits to the examiner that the invention as claimed in Claim 1 is not unpatentable over Kubo (US Patent 5,883,966) in view of Teshima et al (US PGPub 2003/0112993 A1) and as claims 1-4, 7, 9-12 and 17-20 depend on Claim 1, as amended, claims 1-4, 7, 9-12 and 17-20 are in a condition of allowance.

**Re Claim 5:**

The Applicant respectfully submits to the Examiner that even though Claim 5 has been cancelled, Claim 5 even in the previously presented form, was in a condition for allowance as stated *supra* because Kubo (US Patent 5,883,966) does not teach the speaker being in contact with the outer casing and is separated from the casing and rubber rings are present in between the speaker and the outer casing (Fig 4. of Kubo).

**Re Claim 7:**

The Applicant respectfully submits to the Examiner that Claim 7 is not unpatentable over Kubo (US Patent 5,883,966) in view of Teshima et al (US PGPub

2003/0112993 A1) because the spring used in Kubo is not a “drive” means. It performs not overt function to “drive” the speaker. The spring is simply a resilient member which contracts upon applying a force and expands upon release. These forces can be attributed to a person applying them and not to a “drive means” spring as alleged by the Examiner. At best, the person using the phone is the “drive” and there is no “drive means” in Kubo. Moreover, in the present invention, the “drive means” actually influences the resilient member when required ([0014], lines 9-10, of present invention). The drive means does not store energy like a resilient member but transmits energy, if required, against the resilient member.

Based on this argument, the Applicant respectfully submits to the Examiner that Claim 7 is not unpatentable over Kubo (US Patent 5,883,966) in view of Teshima et al (US PGPub 2003/0112993 A1) and is in a condition for allowance.

**Re Claim 10, 11, 12:**

The Applicant respectfully submits to the Examiner that claims 10, 11, and 12 in the previously presented form, are in a condition for allowance as stated *supra* (In Re Claim 1 and In Re Claim 5), because Kubo (US Patent 5,883,966) does not teach every element of the claimed invention, and does not teach that the speaker being in contact with the outer casing. The speaker is, in fact, separated from the casing, and rubber rings are present in between the speaker and the outer casing (Fig. 4. of Kubo). Combining the primary and secondary reference will not result in the claimed invention. Based on this argument, the Applicant respectfully submits to the Examiner that claims 10, 11, and 12 are not unpatentable over Kubo (US Patent 5,883,966) in

view of Teshima et al (US PGPub 2003/0112993 A1) and are in a condition for allowance.

**Re Claim 17, 18, 19, 20:**

The Applicant respectfully submits to the Examiner that claims 17, 18, 19 and 20 are not unpatentable over Kubo (US Patent 5,883,966) in view of Teshima et al (US PGPub 2003/0112993 A1) because the spring used in Kubo is not a “drive” means as explained *supra* In Re Claim 7. Based on this argument, the Applicant respectfully submits to the Examiner that claims 17, 18, 19 and 20 are not unpatentable over Kubo (US Patent 5,883,966) in view of Teshima et al (US PGPub 2003/0112993 A1) and are in a condition for allowance.

### **CONCLUSION**

Based on the preceding arguments, the Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 19-0513.

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/Arlen Olsen/  
Arlen L. Olsen

Registration No. 37,543  
Customer No. 05409

Schmeiser, Olsen & Watts  
22 Century Hill Drive, Suite 302  
Latham, New York 12110  
Tel. (518) 220-1850  
Fax: (518) 220-1857  
Email: aolsen@iplawusa.com